

REMARKS

Claims 9-23 are pending in the present application. By this amendment, claims 10, 11, 16, 18 and the specification are amended. Applicant respectfully submits that the claim amendments are solely for the purposes of clarity and precision. Therefore, Applicant does not believe that the amendments are narrowing. Applicant respectfully requests withdrawal of the rejections and objections, and allowance of the claims.

I. Formalities, Objections

Applicant thanks the Examiner for providing an initialed Form PTO-1449 indicating consideration of the references of record in parent Application No. 09/207,207, and for acknowledging foreign priority. However, the Examiner indicates that none of the certified copies of the priority documents have been received. Applicant respectfully submits that the copies of the priority documents were properly submitted in the parent application. Further, Applicant submits herewith a verified translation of the foreign priority document. Thus, Applicant respectfully requests that the Examiner acknowledge receipt of the priority documents.

Additionally, the Examiner objects to the specification and claims due to various alleged informalities. As shown in the foregoing amendments, Applicant has amended the specification and claims to overcome the Examiner's objections. Thus, Applicant respectfully requests withdrawal of the objections.

II. The claims are in proper condition under 35 U.S.C. § 112, 1st paragraph

Claims 10, 11 and 16 stand rejected due to alleged lack of written description under 35 U.S.C. § 112, 1st paragraph. As shown in the foregoing amendments, Applicant has amended the

claims to overcome the §112, 1st paragraph rejections. Therefore, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 112, 1st paragraph.

III. The claims are novel

Claims 9-12, 15-17 and 19-21 stand rejected due to alleged anticipation under 35 U.S.C. § 102(e) over Shin et al. (U.S. Patent No. 6,271,903, hereafter "Shin"). Applicant respectfully submits that Shin is not a proper reference for application under 35 U.S.C. §102(e), and respectfully requests withdrawal of the rejection.

Applicant respectfully submits that Shin is an improper reference under §102(e) because the foreign priority date of the present application (**December 8, 1997**) antedates the 35 U.S.C. §102(e) date of Shin (**January 22, 1998**). Applicant has met the foreign priority requirements under 37 CFR §1.55(a) and MPEP §201.15, by submission of the documents attached herewith. Thus, Applicant respectfully submits that because the cited reference §102(e) date is after the foreign priority date and is not proper under 35 U.S.C. §102(e), the rejection is improper and should be withdrawn. Therefore, Applicant respectfully requests withdrawal of the anticipation rejections, and allowance of the claims.

IV. The claims would not have been obvious

Claims 13, 14 and 22 stand rejected due to alleged obviousness under 35 U.S.C. § 103(a) over Shin in view of Kondo et al. (U.S. Patent No. 6,198,520, hereafter "Kondo"), claim 18 stands rejected under §103(a) over Shin in view of Miyahara et al. (U.S. Patent No. 6,297,867, hereafter "Miyahara"), and claim 23 stands rejected under §103(a) over Shin in view of Ohta et

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al. (U.S. Patent No. 6,064,460, hereafter "Ohta"). Applicant respectfully submits that rejections are improper, and should be withdrawn for at least the reasons discussed herein.

As noted above, Shin is an improper reference and should therefore be removed as a rejecting reference. Because all of the Examiner's proposed combinations of references require Shin, Applicant respectfully submits that the proposed combinations of references are improper, and should thus be withdrawn.

Additionally, with respect to the rejection of claim 18 under 35 U.S.C. § 103(a) over Shin in view of Miyahara, Applicant respectfully requests disqualification of Miyahara as a rejecting reference under 35 U.S.C. § 103(c), based on the common ownership of Miyahara and the present application.

Applicant respectfully submits that 35 U.S.C. § 103(c) precludes the application of subject matter that qualifies as prior art under only 35 U.S.C. § 102(e)-(g), for applications filed on or after November 29, 1999, where the claimed invention as the cited prior art are subject to an obligation of assignment to the same person at the time the invention was made. For additional explanation, Applicant directs the Examiner to MPEP §706.02(l) and 1241 O.G. 96 (December 26, 2000).

Applicant respectfully submits that Miyahara is only available as prior art under 35 U.S.C. § 102(e) in a §103(a) rejection, and that the present invention has a filing date of April 11, 2001 (based on a parent application filed on December 8, 1998), which is after November 29, 1999. Thus, the present application qualifies for the application of 35 U.S.C. § 103(c).

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Additionally, because both Miyahara and the present invention are subject to an Assignment to NEC Corporation, Applicant respectfully submits that Miyahara can be disqualified under 35 U.S.C. § 103(c), due to common ownership.

Thus, Applicant respectfully requests disqualification of Miyahara under 35 U.S.C. § 103(c). As admitted by the Examiner, Shin alone fails to disclose or suggest all of the claimed combination of features recited in claim 18, and Miyahara cannot be properly combined with Shin for the reasons discussed herein. Therefore, Applicant respectfully submits that claim 18 is allowable over the art of record, and requests allowance of claim 18.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

The specification is changed as follows:

Page 15, 1st full paragraph:

Another chrome film is formed on the counter substrate 12, followed by patterning thereof to form the black matrix 19 for covering substantially all over the area other than the pixel area. A color filter 20 is formed thereon using the three photolithographic steps for a polyimide based layer, made by dispersing R-G-B pigments in a photosensitive polymer. The overcoat layer 22 is then form by spin-coating and subsequent patterning of polyimide. The overcoat layer 22 prevents impurity ions eluted from the color filter 20 from being mixed into the LC layer 18. The overcoat layer [12]22 also functions for flattening the surface of the counter substrate 12, controlling the thickness of the LC layer 18, and suppressing disclination, so as to obtain an excellent image quality.

IN THE CLAIMS:

The claims are amended as follows:

10. (Amended) The method of claim 9, further comprising forming a film [between]on said second substrate and patterning said film to form said black matrix.

11. (Amended) The method of claim 10, wherein said step of forming a film comprises forming a chrome film [between]on said second substrate and patterning said chrome film to form said black matrix.

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16. (Amended) The method of claim 9, further comprising positioning a plurality of polarizing plates for sandwiching [between] said first substrate and said second substrate between said polarizing plates.

18. (Amended) The method of claim 9, wherein forming said gate insulating film comprises silicon oxide, an amorphous silicon layer and a N+ type amorphous silicon layer formed on said scanning lines and [pixel]common electrodes.